

ESTTA Tracking number: **ESTTA530919**Filing date: **04/08/2013**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**Notice of Opposition**

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Vanity Fair, Inc.
Granted to Date of previous extension	04/10/2013
Address	One Fruit of the Loom Drive Legal Department Bowling Green, KY 42103 UNITED STATES

Attorney information	Carrie A. Shufflebarger Thompson Hine LLP 312 Walnut Street Fourteenth Floor Cincinnati, OH 45202 UNITED STATES carrie.shufflebarger@thompsonhine.com, sharon.bella@thompsonhine.com, lou.ebling@thompsonhine.com, docket@thompsonhine.com, ipdocket@thompsonhine.com Phone:513.352.6678
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Applicant Information

Application No	79101970	Publication date	12/11/2012
Opposition Filing Date	04/08/2013	Opposition Period Ends	04/10/2013
International Registration No.	1089163	International Registration Date	04/05/2011
Applicant	BOURDIN VALERIE Rue Oscar II Gustavia F-97133 SAINT BARTHELEMY, FRANCE		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Clothing, namely, pants, tops, dresses, skirts, suits, jackets, leggings, blouses, shirts, camisoles, shorts, sweaters, sweat pants, sweat shirts, T-shirts, shoulder wraps, coats, suits, vests, gloves, aprons, bathrobes, belts, capes, cloaks, scarves, pajamas, underwear, lingerie, swimsuits; Footwear; Headgear, namely, hats, caps, shawls, headbands and berets
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	918102	Application Date	06/23/1970
Registration Date	08/10/1971	Foreign Priority Date	NONE
Word Mark	VANITY FAIR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class U039 (International Class 010, 025, 026). First use: First Use: 1970/05/28 First Use In Commerce: 1970/05/28 [PAPER SLIPS,] PETTI-SLIPS, AND BRIEFS		

U.S. Registration No.	2185908	Application Date	08/07/1997
Registration Date	09/01/1998	Foreign Priority Date	NONE
Word Mark	VANITY FAIR		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1996/08/00 First Use In Commerce: 1996/08/00 pajamas, [robes, peignoir sets, bed jackets, scuffs, teddies,] nightgowns, [thermal underwear,] slips, chemises, thong underwear, bustiers, camisoles, bras, [panty hose, leggings, socks,] body suits, briefs, panties, pant liners, girdles, bodybriefers, and panty-girdles		

U.S. Registration No.	2808866	Application Date	04/15/2003
Registration Date	01/27/2004	Foreign Priority Date	NONE
Word Mark	VANITY FAIR		
Design Mark			


Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1915/00/00 First Use In Commerce: 1915/00/00 Foundation garments, lingerie, underwear, bras, slips, loungewear, robes, sleepwear [and hosiery]

U.S. Registration No.	3127692	Application Date	05/06/2004
Registration Date	08/08/2006	Foreign Priority Date	NONE

Word Mark	VANITY FAIR
Design Mark	 The design mark for the 'VANITY FAIR' trademark is a stylized, serif font with a slightly distressed or textured appearance. The letters are bold and evenly spaced, with a subtle shadow or outline effect that gives it a three-dimensional feel. The background of the design mark is a light, mottled gray, suggesting a textured surface like paper or fabric.

Description of Mark	NONE
Goods/Services	Class 035. First use: First Use: 1992/04/15 First Use In Commerce: 1992/04/15 [retail store services in the field of apparel;] providing consumer product information via the Internet

U.S. Registration No.	3632523	Application Date	02/15/2008
Registration Date	06/02/2009	Foreign Priority Date	NONE

Word Mark	VANITIES BY VANITY FAIR
Design Mark	 The design mark for the 'VANITIES BY VANITY FAIR' trademark is a stylized, serif font with a slightly distressed or textured appearance. The letters are bold and evenly spaced, with a subtle shadow or outline effect that gives it a three-dimensional feel. The background of the design mark is a light, mottled gray, suggesting a textured surface like paper or fabric.
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2008/04/14 First Use In Commerce: 2008/04/14 Panties; Lingerie; Bras

Attachments	72363405#TMSN.gif (1 page)(bytes) 75337183#TMSN.gif (1 page)(bytes) 78414013#TMSN.jpeg (1 page)(bytes) 77398636#TMSN.jpeg (1 page)(bytes) Notice of Opposition.pdf (6 pages)(21340 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Carrie A. Shufflebarger/
Name	Carrie A. Shufflebarger
Date	04/08/2013

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of

Application No. : 79/101,970
Applicant : Valerie Bourdin
Mark : VANITA ROSA
Filing Date : April 5, 2011
Publication Date : December 11, 2012
Opposed Class: : 25

VANITY FAIR, INC., :
:
Opposer, :
:
v. :
:
VALERIE BOURDIN :
:
Applicant. :
:

Opposition No. _____

NOTICE OF OPPOSITION

Opposer, Vanity Fair, Inc., a corporation duly organized and existing under the laws of the State of Delaware, having a mailing address at One Fruit of the Loom Drive, Bowling Green, Kentucky 42103, believes it will be damaged by registration of the mark VANITA ROSA shown in Application Serial No. 79/101,970, and hereby opposes registration of said mark.

As grounds of opposition, it is alleged that:

1. Opposer is Vanity Fair, Inc., owner of the famous VANITY FAIR brand of apparel. Opposer is the owner of, is currently using, and has itself and through its predecessors-in-interest continuously used in U.S. commerce for nearly a century marks consisting of or incorporating “VANITY FAIR” in connection with, inter alia, foundation garments, apparel, and textile goods (the “VANITY FAIR Marks”).

2. Opposer owns numerous federal registrations on the Principal Register for its VANITY FAIR Marks, including without limitation the following, many of which have become incontestable within the meaning of the Lanham Act:

Trademark	Serial/Reg.	First Use	Goods
<i>Vanity Fair</i>	918,102	1970	Petti-slips and briefs
<i>Vanity Fair</i>	2,185,908	1996	pajamas, nightgowns, slips, chemises, thong underwear, bustiers, camisoles, bras, body suits, briefs, panties, pant liners, girdles, bodybriefers, and panty-girdles
VANITY FAIR	2,808,866	1915	Foundation garments, lingerie, underwear, bras, slips, loungewear, robes, sleepwear
VANITY FAIR	3,127,692	1992	providing consumer product information via the Internet
VANITIES BY VANITY FAIR	3,632,523	2008	Panties; Lingerie; Bras

3. Opposer has expended substantial amounts of money, time, and effort in advertising, promoting, and popularizing its VANITY FAIR Marks over many years and in preserving the good will associated therewith.
4. Opposer's VANITY FAIR Marks have become distinctive of and associated in the minds of the trade and purchasing public with Opposer as a well-known provider of its goods.
5. The public has come to know Opposer's VANITY FAIR Marks and recognize that any goods so marked originate with Opposer. By virtue of these efforts and by virtue of the excellence of its goods, Opposer has gained a valuable reputation for its VANITY FAIR Marks.

6. Valerie Bourdin, an individual domiciled in France, filed Application Serial No. 79/101,970 under Section 66(a) of the Lanham Act on April 5, 2011 (“Application”), seeking registration of the trademark VANITA ROSA (“Applicant's Mark”) for the following goods in International Class 25:

Clothing, namely, pants, tops, dresses, skirts, suits, jackets, leggings, blouses, shirts, camisoles, shorts, sweaters, sweat pants, sweat shirts, T-shirts, shoulder wraps, coats, suits, vests, gloves, aprons, bathrobes, belts, capes, cloaks, scarves, pajamas, underwear, lingerie, swimsuits; Footwear; Headgear, namely, hats, caps, shawls, headbands and berets
7. The English translation of “Vanita Rosa” in Applicant’s Mark is “Vanity Rose.”
8. Priority is not an issue: Opposer’s longstanding use of its VANITY FAIR Marks described above is well prior to the filing date of the Application or any priority date Applicant may claim based on her International Registration No. 1089163.
9. The goods identified in the Application are identical or highly related to Opposer’s goods sold under the VANITY FAIR Marks, and are likely to be sold through the same channels of trade as Opposer’s goods sold under its VANITY FAIR Marks.
10. Applicant's Mark so resembles the marks previously used by Opposer in commerce as to be likely, when used in connection with Applicant's goods, to cause confusion, deception or mistake as to the affiliation, connection or association of Applicant with Opposer, and/or the origin, sponsorship, or approval of Applicant's goods or commercial activities by Opposer under 15 U.S.C. § 1052(d). The aforesaid likelihood of confusion will damage Opposer within the meaning of 15 U.S.C. § 1063.

11. Opposer's VANITY FAIR Marks are famous and distinctive within the meaning of the Lanham Act.
12. Opposer's VANITY FAIR Marks became famous long prior to the filing date of the Application.
13. Registration of the highly similar Applicant's Mark will lessen the capacity of Opposer's famous and distinctive VANITY FAIR Marks to distinguish and identify Opposer's goods and services from those of others, thereby diluting the distinctive quality of Opposer's VANITY FAIR Marks in violation of 15 U.S.C. § 1125(c), and causing damage to Opposer within the meaning of 15 U.S.C. § 1063.
14. Opposer would be damaged by registration of Applicant's Mark because registration would grant Applicant statutory rights under the Trademark Act of 1946, and would tend to restrict, interfere with, and damage Opposer in the unhampered conduct of its business and protection of its legitimate interests.

WHEREFORE, Opposer prays this Opposition be sustained, and registration of the Application cited above be refused.

Please charge the appropriate filing fee to the credit card account of Opposer's counsel, as provided through the ESTTA filing system.

Please direct all correspondence to Carrie A. Shufflebarger, Esq., at Thompson Hine, LLP, 312 Walnut Street, Fourteenth Floor, Cincinnati, Ohio 45202, and all calls to the same at (513) 352-6678.

Signature Page Follows

Respectfully submitted,

/s/ Carrie A. Shufflebarger

Carrie A. Shufflebarger, Esq.
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Date: April 8, 2013

CERTIFICATE OF FILING

I certify that this NOTICE OF OPPOSITION is being submitted electronically to the Trademark Trial and Appeal Board at the United States Patent and Trademark Office on this 8th day of April, 2013.

/s/ Carrie A. Shufflebarger

Carrie A. Shufflebarger

CERTIFICATE OF SERVICE

I certify that a copy of this NOTICE OF OPPOSITION is being served via First Class mail, postage prepaid, on the following, on this 8th day of April, 2013.

Jacob Laufer
1660 60th Street
Brooklyn, New York 11204

Valerie Bourdin
Rue Oscar II Gustavia
F-97113 Saint Barthelemy
France

/s/ Carrie A. Shufflebarger

Carrie A. Shufflebarger